

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 21, 2009 has been entered.

Claim Objections

2. Claim 1 is objected to because of the following informalities:

Claim 1 (line 2) recites "motor comprising: ". It should recite --motor, the case comprising: --.

Claim 1 (lines 8-9) recites "the hole... aligns with the hole". It should recite --each said hole... aligns with a respective said hole--.

For the purpose of examining the application, it is assumed that appropriate correction has been made.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Willy Voit (EP 0 446 866).

As to claim 1, Willy Voit discloses a solid, unflanged case housing an assembly for generating torque in a car start motor (tubes **1,5** are formed of a solid material and lack any flanges, thus constituting a solid, unflanged case, as shown in Figure 6), the case comprising:

a solid inner tube **1** comprising at least one hole **2** extending through a tube wall perpendicular to an axis of the inner tube; and

a solid outer tube **5** comprising at least one hole **3** extending through a tube wall perpendicular to an axis of the outer tube;

wherein the solid inner tube and the solid outer tube are firmly coupled to each other by force fitting the inner tube into the outer tube such that each hole of the inner tube aligns with a respective hole in the outer tube;

and wherein the hole of the outer tube is inserted into the hole of the inner tube to retain a firm coupling state (hole **3** extends through the entire width of wall **7** of outer tube **5**; Figure 8), wherein the hole of the outer tube and the hole of the inner tube are capable of being formed simultaneously when the tubes are processed (Figures 6-8, abstract).

Applicant is reminded that **process limitations are given little patentable weight in product claims** since the patentability determination of product-by-process claims is based on the product itself, even though such claims are limited and defined by the process. See MPEP § 2113. "The patentability of a product does not depend on

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its method of production. “ In re Thorpe, 777 F.2d 695,698,USPQ 964,966 (Fed.Cir.1985). Accordingly, the process limitation of the hole of the outer tube and the hole of the inner tube being formed simultaneously in claim 1 is given little patentable weight; all that is required of claim 1 is that the hole of the outer tube and the hole of the inner tube are capable of being formed simultaneously. Accordingly, the Willy Voit reference has been interpreted to read on such claim.

As to claim 2, Willy Voit discloses a case wherein the hole **3** of the outer tube **5** is smaller than the hole **2** in the inner tube **1** (Figure 8).

As to claim 3, Willy Voit discloses a case wherein the hole **3** of the outer tube **5** and the hole **2** of the inner tube **1** are circular (Figure 8).

As to claim 4, Willy Voit discloses a case wherein the diameter of the hole **3** of the outer tube **5** is less than the diameter of the hole **2** in the inner tube **1** (Figure 8).

As to claim 5, Willy Voit discloses a case wherein the hole **3** of the outer tube **5** inserted into the hole **2** of the inner tube **1** is dimpled (Figure 8).

Response to Arguments

5. Applicant's arguments filed September 21, 2009 have been fully considered but they are not persuasive.

As to claim 1, Attorney argues that:

Willy Voit does not disclose a case wherein the hole of the outer tube and the hole of the inner tube *are formed simultaneously when the tubes are processed*.

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Examiner disagrees. As to claim 1, Willy Voit discloses a case wherein the hole **3** of the outer tube **5** and the hole **2** of the inner tube **1** are capable of being formed simultaneously when the tubes are processed (Figures 6-8, abstract).

Applicant is reminded that **process limitations are given little patentable weight in product claims** since the patentability determination of product-by-process claims is based on the product itself, even though such claims are limited and defined by the process. See MPEP § 2113. "The patentability of a product does not depend on its method of production. " In re Thorpe, 777 F.2d 695,698,USPQ 964,966 (Fed.Cir.1985). Accordingly, the process limitation of the hole of the outer tube and the hole of the inner tube being formed simultaneously in claim 1 is given little patentable weight; all that is required of claim 1 is that the hole of the outer tube and the hole of the inner tube are capable of being formed simultaneously. Accordingly, the Willy Voit reference has been interpreted to read on such claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL P. FERGUSON whose telephone number is (571)272-7081. The examiner can normally be reached on M-F (6:30am-3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571)272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MPF
10/30/09

/Michael P. Ferguson/
Primary Examiner, Art Unit 3679